



PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Weiner

Examiner: M. Daniels

Serial No.: 10/606,074

Group Art Unit: 1791

Filed June 25, 2003

For: Imbedded Vinyl Products and Method of Producing Same

REPLY BRIEF ON APPEAL

Commissioner of Patents and Trademarks
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Further to the Examiner's Answer of September 29, 2008, ("Answer"), herewith the Applicant respectfully responds.

I. RESPONSE TO GROUNDS OF REJECTION

A. Anticipation and/or obviousness rejections of claims 1, 4-6 and 13 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious principally over Weaver (USPN 3,923,941) with Bartlett, Fine and Suzuki.

The Applicant remains in disagreement with the characterization of Weaver as provided by the Answer. Specifically, the Applicant maintains that Weaver shows conveyor belt **14** transporting a substrate **9**. (See Column 3, lines 31-34 and 36-39.) A marbled coating **19** is then applied to the substrate **9** and then jelled by passing it through heating means (Column 3, line 39). Clear top coating **21** is then applied on top of the marbled coating **19**. (Column 3, lines 36-39 and 49-58). The coatings **19,21** are then fused by heating arrangement **23**.

i. Substrate 9 is not a conveyor.

The conveyor is a conveyor belt **14**, and not the substrate **9**, as argued in the Answer. The substrate **9** is identified as a layer of the composite sheet **24** and is conveyed by the conveyor which is identified as conveyor belt **14**. Using the Argument of the Answer, if a candy bar were being conveyed on the conveyor belt **14**, the argument would follow that the candy bar was a “conveyor” which, of course, is not accurate. The proposed interpretation is believed to be a twist of the claim language in an unintended direction which is not consistent with what one of ordinary skill in the art would expect.

ii. The definition of “streams” proposed by the Answer is not what one of ordinary skill in the art would expect.

The Answer is believed to be the first instance in which an issue has been identified with the term “streams.” No citation is provided for the interpretation of this term provided in the Answer. Furthermore, the proposed interpretation is not believed to adhere to what one of ordinary skill in the art would expect, particularly in light of the specification.

The “streams” term was added in a response to the first Office Action, roughly four Office Actions ago. Until the Answer, its meaning as argued by the Answer was not ascribed the meaning now relied upon by the Answer. Support for “streams” is believed to be clearly taught by the specification as originally filed in Paragraphs [00012], [00013] and [00014] which are described as liquid vinyl of various viscose properties (Line 2 of Paragraph [00014]) and distributed from a hopper **24** (Last paragraph of paragraph [00012]), and further in Paragraph [00010], the specification is quite clear in advising that droplets **30** are representative of liquid vinyl which could take “other forms as they leave the hopper **24**”.

“Streams” are believed to distinguishable from rolled on application. The Answer’s new broad interpretation of the term “stream” so that it can include rolled on coatings is not believed to be appropriate and is certainly not what is intended by the claimed terminology. Instead of allowing the patentee to be the lexicographer, the Answer takes over that role which is not believed to be proper, particularly at this late stage of prosecution. Adopting an unsupported definition of a term proposed by contrary to the specification is not believed to be appropriate.

Nevertheless, the Applicant would be more than happy to remove the term “streams” from claim 1 if that would put the remainder of the claims in proper form for allowance. The “streams” embodiment could then be addressed through a divisional application, particularly since this is believed to be the first time the term “streams” has now been somewhat objected to by the Patent Office, and certainly interpreted in the way it is now being argued in the Answer. There are other terms that may be utilized a flow of fluid from a source downwardly (such as from a hopper) onto the conveyor which is clearly a different deposition technique than the rolled-on method relied upon by the Answer which is not believed to be a “stream.”

iii. Response to Applicant’s remarks -- Weaver teaches away from inverted installation.

The Answer states that: “It does not appear to be the case that Weaver suggests or requires any particular orientation in installing the material as suggested by the Appellant.” The Applicant respectfully disagrees. Column 3, lines 49-60 describe: “A clear, unfilled, unpigmented *top* coating material may then be applied by means of a doctor blade . . .”. (emphasis added). A top coating is just that, a top surface. A substrate is just that, a surface below another surface, i.e., a substrate. In fact, the Weaver specification states: “The substrates surface may or may not have a release coating thereon depending on whether or not retention of

the substrate backing is desired.” Column 2, lines 13-16. The position taken by the Answer is simply not believed to be persuasive. There is not believed to be any suggestion orientation in Weaver which would support installing the structure in Weaver in an upside down manner. In fact, Weaver is believed to expressly teach away from such an installation. Terminology such as “first” and “second” layer could have been used if inversion were envisioned as a possibility. When the Answer states: “Weaver describes the top coating only to distinguish from the colored materials applied against the conveyor”, the applicant respectfully disagrees and believes there is no support for this position except for the Applicant’s specification and claims.

As it relates to the attempt at changing the word “conveyor” into a functional language of conveying, the Applicant respectfully disagrees with such an analysis. The substrate **9** is conveyed by the conveyor **14**. The substrate **9** does not function as a conveyor. In fact, the Weaver specification states: “various movements could be imparted to the substrate . . . to achieve the desired patterns.” Column 5, lines 43-45.

As it relates to the rejection of claims 2-3, modifying Weaver is proposed by the Examiner to provide a scrim above the top coating. The “top” coating would then be obscured by the scrim and thus rendered unusable for its intended purpose as it would no longer be the “top” coating. Such a modification is believed to be expressly taught away from by the Weaver reference.

· Claim 5 stands or falls with claim 1 from which it depends.

Claim 7 requires that the liquid design material be applied from the hopper through a plurality of orifices to the conveyor. Without utilizing the Applicant’s claim as a roadmap, there is simply no motivation to combine Mell with Weaver to provide the claimed structure. Furthermore, the proposed combination is not believed to work for its intended purpose as if

more than one orifice is provided, the ball 8 would then appear to be in one of the orifices therein, and Weaver would then not work for its intended purpose and is expressly taught away from as some fluid would appear to be imparted onto the substrate 9 through an orifice without contacting the roller 8 and thus not provide the desired marbled finish described in that reference. Claims 8 and 9 can stand or fall with claim 7.

As it relates to claim 10, the Applicant appreciates the Examiner withdrawing the rejection as it relates to claim 10. There being no other rejections related to claim 10, claim 10 is believed to be allowable.

Claim 13 stands or falls with claim 1.

Finally, claim 14 requires the conveyor to have at least two different heights. The Examiner takes the position that the combination of the substrate 9 of Weaver combined with a dye face structure in Suzuki teaches an ability to provide a conveyor 14 having at least two heights on its surface to impart texture to what will become the top layer. The Applicant respectfully disagrees with the Answer's argument. There is motivation or suggestion to provide a dye imprint face to a conveyor 14, or even substrate 9, as relied upon by the Office Action and it is only by using the Applicant's specification that such a motivation can be found.

II. CONCLUSION

In conclusion, it is believed that claim 10 is currently allowable as apparently agreed to by the Answer. Apparently the only rejection related to that claim was withdrawn with the Answer. This leaves claims 1-9 and 13 and 14 at issue. The Applicant believes that the Applicant's arguments presented are more persuasive than those found in the Answer or Office Actions and respectfully requests allowance of all claims 1-10 and 13 and 14.

However, if claim 1 remains rejected, the Applicant respectfully requests the removal of the term "stream" as there is no teaching or suggestion for particulate or droplets and other terminology relating to the application of a fluid from above rather than being rolled. Another term for a non-rolled "stream" embodiment can then be pursued through a divisional application, if necessary.

Respectfully submitted,

Date: December 2, 2008

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

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on this 2nd day of December, 2008.

By: Beverly L. Middleton
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